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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/670,378

09/26/2003

Thomas DeWitt Smith

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CLARK & BRODY

1090 VERMONT AVENUE, NW

SUITE 250

WASHINGTON, DC 20005

EXAMINER

CLAYTOR, DEIRDRE RENEE

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

11/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/670,378

Applicant(s)

SMITH, THOMAS DEWITT

Examiner

Renee Claytor

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 7, 9, 17, 18, 20, 21, 26, 37 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-7, 9, 17-18, 20-21, 26, 37, 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Applicant's remarks filed 9/10/2007 is hereby acknowledged. Applicants have canceled claims 1-5, 8, 19 and 38-40. Therefore, claims 6, 7, 9, 17, 18, 20, 21, 26, 37 and 41 are pending and under examination herein.

Response to Arguments

Applicants have amended claims 17, 21 and 40, which is sufficient to overcome the objections to the claims. Accordingly, the objection to the claims is hereby withdrawn.

Applicant's arguments over the 35 USC 103 rejection over Wagner et al. (US Patent 5,951,991) have been considered. Applicants argue that the teachings of Wagner et al. are drawn to a 3 component system consisting of an inert woven or sponge-like material, a lathering surfactant, and conditioning emulsion and the conditioning emulsion is deposited on the substrate in a dry condition and then deposited on the skin with the aid of water. Applicants assert that Wagner makes no mention of the entity as an absorption base or its utility for skin use alone. It is further argued that Wagner does not teach a diluting step (regardless of the temperature limitation). Applicants have further amended claims 6 and 17 to incorporate the limitation of diluting the mixture with heated water.

Applicant's arguments and amendments are found persuasive. While Wagner et al. teaches a method of making an emulsion comprised of the same ingredients of the

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instant application, e.g., petrolatum and methyl glucose dioleate, it is not taught that the mixture is diluted. Therefore, the 35 USC 103 rejection over Wagner et al. is withdrawn.

Applicant's arguments over the 35 USC 103 rejection over Narula (US Patent 4,788,001) in view of McAtee et al. (US Patent 6,153,208) have been considered.

Applicants argue Narula teaches PEG-120 methyl glucose dioleate differs from the presently claimed methyl glucose dioleate by the addition of 120 ethylene oxide units per molecule and an HLB of 16. Applicant further teaches that Narula does not teach any of the heating steps and that McAtee et al. does not fill in the deficiencies.

Applicant points out that McAtee et al. teaches a 3-component system and that is not similar to the invention of Narula.

Applicant's arguments against Narula regarding the teaching by Narula of PEG-120 methyl glucose dioleate are found persuasive. Therefore, the rejection is being modified without relying on the PEG-120 methyl glucose dioleate in the emulsified system.

Claim Rejections – 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7, 9, 17-18, 20-21, 26, 37, 41 rejected under 35 U.S.C. 103(a) as being unpatentable over Narula (US Patent 4,788,001) in view of McAtee et al. (US Patent 6,153,208).

Narula teaches methods of making oil-in-water emulsions that are comprised of petrolatum (Col. 3, lines 18-19). Narula teaches that the emulsions are diluted with water (Col. 7, lines 42-47).

Narula does not teach heating the petrolatum up to 80°C, diluting the emulsion with water preheated up to 50°C, the addition of a preservative system (specifically DMDM hydantoin and iodo propynyl butyl carbamate), or the addition of hydrocortisone.

McAtee et al. teaches methods of making compositions with a conditioning emulsion comprised of an oil soluble conditioning agent, including petrolatum (Col. 25, line 58 and Col. 26, lines 13-21) and methyl glucose dioleate as the emulsifier (Col. 30, line 53). Active ingredients include hydrocortisone (meeting the limitation of claims 9, 20, 26-27 and 37-38; Col. 45, line 14 and Col. 48, line 8). Examples 6-10 state that the ingredients of the conditioning emulsion are mixed at between 75-115°C (further meeting the limitation of claims 6 and 17; Col. 54). Other ingredients that can be incorporated into the conditioning emulsion include Glydant Plus (meeting the limitations of claims 7, 21 and 39-41; Col. 47, lines 4-5).

Furthermore, it is obvious to vary and/or optimize the temperature to dilute the emulsion with water at 50°C provided in the composition, according to the guidance provided by McAtee et al., to provide a stable composition. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover

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the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is also noted that it has been held that merely changing the order of steps in a multi-step process is not a patentable modification absent a showing of unexpected results. *Ex parte Rubin* 128 USPQ 440 (POBA 1959).

Accordingly, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069, 1072 (CCPA 1980). In the instant case, one would have been motivated to make an absorption base comprised of petrolatum and methyl glucose dioleate because of the teachings of Narula and McAtee et al. that both agent are used as emulsifiers and it would be obvious to a person of ordinary skill in the art to make an absorption base with excellent emulsifying properties.

Conclusion

No claims are allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is 571-272-8394. The examiner can normally be reached on M-F 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor

A handwritten signature in black ink, appearing to read 'S. Padmanabhan', with a horizontal line underneath.

**SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER**